

REMARKS

This application has been carefully reviewed in light of the Office Action dated March 20, 2003. Claims 1-7 remain pending in this application. Claim 1 is the independent claim. Favorable reconsideration is respectfully requested.

Applicants note with appreciation the indication that Claims 2-7 would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims. Applicants respectfully refrain from so amending Claims 2-7 at this time because they feel their respective base claims to be allowable.

In response to the Office Action's objections to the specification, Applicants respectfully believe the amendments to the specification and abstract adequately respond to the objection and render it moot. Applicants request withdrawal of the objection to the specification.

On the merits, the Office Action rejected Claim 1 under 35 U.S.C. § 102(e) as being unpatentable over Chien (U.S. Patent No. 6,225,871; hereinafter "Chien"). Applicants respectfully traverse the rejections.

Applicants' Claim 1 recites, in pertinent part: "[a] LC controllable oscillator (LCCO) comprising... a replica scaled bias module (RSBM) (103) supplied from the external voltage source (105)

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via the first conductor SUP and the second conductor (REF), the RSBM (103) is conceived to generate a control signal (BIAS CONTROL) for controlling the supplied current (104) delivered by the first VCCS (101) to the VCO (102)."

Chien fails to recite or suggest: 1) a replica scaled bias module (RSBM) (103) supplied from the external voltage source (105) via the first conductor SUP and the second conductor (REF); and 2) that the RSBM (103) is conceived to generate a control signal (BIAS CONTROL) for controlling the supplied current (104) delivered by the first VCCS (101) to the VCO (102).

The argument that the means for generating control voltage is inherent is respectfully traversed. As indicated in Applicants' specification, the replica current in the RSBM module modifies the supply current of the VCO 102 and this improves the thermal stability and the phase noise margin of the LCCO. Even though Chien requires some control voltage and means for generating such a control voltage does not necessarily mean that it is generated by the same means as recited in Applicants' Claim 1.

Applicants respectfully note that a missing element is inherently present in a reference only if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art (as opposed to the examiner's expectation). Mere possibilities or even probabilities are not

enough; necessity recognized by those of skill in the art is required.¹ The M.P.E.P. echoes this case law.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

Further, the following is also emphasized:

In relying upon the theory or inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

It is well established that a recited element or step is inherently present in a prior art reference only if that element is necessarily present or necessarily performed in that reference, and further that its presence or performance would be recognized by one of ordinary skill in the art from what has been expressly described. Second, the Office Action must provide objective

¹ The Federal Circuit has clearly set out the standard for inherency in, e.g., Continental Can Co. v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In re Oelrich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting Hanseig v. Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

This citation is also set out in M.P.E.P. § 2131.01(d).

evidence or cogent technical reasoning to support a contention of inherency.

Nothing found in Chien recites or suggests a replica scaled bias module (RSBM) (103) supplied from the external voltage source (105) via the first conductor SUP and the second conductor (REF), the RSBM (103) is conceived to generate a control signal (BIAS CONTROL) for controlling the supplied current (104) delivered by the first VCCS (101) to the VCO (102). Simply because Chien requires control voltage, the mere possibility of using a RSBM which generates a control signal as recited in Claim 1 is insufficient to support an inherency argument. Claim 1 is believed patentable over Huang for at least these reasons.


Claims 2-7 depend from independent Claim 1 discussed above and are believed patentable for at least the same reasons. In addition, Applicants respectfully believe Claims 2-7 to be independently patentable and request separate consideration of each claim.

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned agent may be reached by telephone at the number given below.

Respectfully submitted,

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